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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,110	06/16/2000	Kazumoto Kondo	450100-02572	2719
20999	7590	05/03/2004		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER	SMITH, PETER J

ART UNIT	PAPER NUMBER
2176	9

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

X

Office Action Summary	Application No.	Applicant(s)
	09/596,110	KONDO, KAZUMOTO
	Examiner	Art Unit
	Peter J Smith	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 June 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 2/19/2004, application filed on 06/16/2000.
2. Claims 1-6 are pending in the case. Claims 1 and 4 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 3-4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Huffman et al. (hereafter referred to as Huffman), US 5,663,748 issued 09/02/1997.**

Regarding independent claim 1, Huffman discloses a display means for displaying multiple elements forming contents of book in fig. 1-7, and col. 3 line 64 – col. 4 line 3. Huffman discloses a display control means for determining, based upon a selection technique for specifying one of said multiple elements, a type of mark to emphasize a specified element, said selection technique being defined according to a position specified by an area of the display touched by a user displaying the specified element when an optional element is specified from among said multiple elements via input means and for attaching said determined mark to said specified element in fig. 19, 23, 27, and col. 17 line 62 – col. 18 line 24. The selection of elements to be marked is shown in fig. 19. The selection technique is defined according to a

position specified by an area of the display touched by a user displaying the specified element in fig. 20.

Regarding dependent claim 3, Huffman discloses changing the display condition of a mark displayed on a specified element according to the specified operational procedure via an input means in fig. 19, 23, 27 and col. 17 line 62 – col. 18 line 24.

Regarding independent claim 4, Huffman discloses a display means for displaying multiple elements forming contents of book in fig. 1-7, and col. 3 line 64 – col. 4 line 3. Huffman discloses a display control means for determining, based upon a selection technique for specifying one of said multiple elements, a type of mark to emphasize a specified element, said selection technique being defined according to a position specified by an area of the display touched by a user displaying the specified element when an optional element is specified from among said multiple elements via input means and for attaching said determined mark to said specified element in fig. 19, 23, 27, and col. 17 line 62 – col. 18 line 24. The selection of elements to be marked is shown in fig. 19. The selection technique is defined according to a position specified by an area of the display touched by a user displaying the specified element in fig. 20.

Regarding dependent claim 6, Huffman discloses changing the display condition of a mark displayed on a specified element according to the specified operation procedure via an input means in fig. 19, 23, 27 and col. 17 line 62 – col. 18 line 24.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman et al. (hereafter referred to as Huffman), US 5,663,748 issued 09/02/1997 in view of Hasting et al. (hereafter referred to as Hastings), US 5,885,012 issued 03/23/1999.**

Regarding dependent claim 2, Huffman does not teach a display control means which changes the display condition of a mark according to the number of times the specified element is specified. Hasting does teach does teach a display control means which changes the display condition of a mark according to the number of times the specified element is specified in col. 10 lines 26-42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hastings into Huffman to have created the claimed invention.

It would have been obvious and desirable to incorporate a means for creating different versions of the same mark such as a varying underline thickness. This would have allowed the user to have more significantly marked the most important passages and less significantly marked passages of modest importance. This would have helped the user of the electronic book to have better organized the text contained in their electronic book.

Regarding dependent claim 5, Huffman does not teach changing the display condition of a mark according to the number of times the specified element is specified. Hastings does

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teach changing the display condition of a mark according to the number of times the specified element is specified in col. 10 lines 26-42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Hastings into Huffman to have created the claimed invention.

It would have been obvious and desirable to incorporate a means for creating different versions of the same mark such as a varying underline thickness. This would have allowed the user to have more significantly marked the most important passages and less significantly marked passages of modest importance. This would have helped the user of the electronic book to have better organized the text contained in their electronic book.

Response to Arguments

7. Applicant's arguments filed 2/19/2004 have been fully considered but they are not persuasive. Regarding Applicant's arguments on page 5 that Huffman does not disclose that the user directly touches the display screen of the electronic book, and based upon a portion of the text that is touched, either a highlighting or an underlining function is performed (implied to the Examiner that the text selection and highlighting or underlining takes place in one single step), the Examiner agrees that this description, as the Examiner understands is performed in one combined step, of Applicant's invention in the remarks section is not anticipated by Huffman. However, the Examiner believes that, as claimed, Huffman does in fact anticipate a selection technique which is defined according to a position specified by an area of the display touched by a user.

The Examiner views the broadest reasonable interpretation of this limitation as the entire display because it is limited only as “an area of the display touched by the user”. Using this interpretation, Huffman’s text marking selection menu, is presented in “an area of the display” for the user to select a type of mark including an underline or highlight. The Examiner also does not observe language in the claim in its broadest reasonable interpretation which ties the actions of element selection and mark selection into one single action performed by the user. The Examiner believes the selection technique being defined according to a position specified by an area of the display touched by a user could occur at a point in time after the specifying of elements is performed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
April 30, 2004



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER